

REMARKS

Applicants gratefully acknowledge the telephonic interviews conducted with the examiner on April 15, 2008.

Claims 1 and 3-21 were pending in the application. Claims 1, 4, 5, 8, 9, 10, 13 have been amended. Accordingly, upon entry of the present amendment, Claims 1 and 3-21 will remain pending in the application.

Support for the amendments to the claims may be found throughout the specification and claims as originally filed. *No new matter has been added.*

Any amendments to and/or cancellation of the claims are not to be construed as an acquiescence to any of the rejections set forth in the instant Office Action, and were done solely to expedite prosecution of the application. Applicants hereby reserve the right to pursue the subject matter of the claims as originally filed in this or a separate application(s).

Rejection of Claims 1, 3-17, and 21 under U.S.C. 112, Second Paragraph

The Examiner has rejected claims 1, 3-17, and 21 under 35 U.S.C 112, second paragraph as allegedly “being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.”

With respect to claim 1, the Examiner is of the opinion that claim 1 is “vague and indefinite”

[i]n view of the phrase “said 3’ recognition sequence being combined with a DNA methylation recognition sequence” in step a) of the claim because it is unclear that this phrase means that said 3’ recognition sequence is adjacent to a DNA methylation recognition sequence or said 3’ recognition sequence comprises a DNA methylation recognition sequence or mean something else.

Applicants respectfully submit that, in view of the amendments to claim 1, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 1 be reconsidered and withdrawn.

With respect to claim 1, the Examiner is further of the opinion that claim 1 is “vague and indefinite”

[i]n view of steps b) to d). Since step b) does not indicate that an accessible restriction site in a starting DNA construct is identical to the restriction enzyme site of said restriction enzyme, it is unclear how to cleave the ligated product containing a DNA modification generated in step c) with said restriction enzyme in step d).

Applicants respectfully submit that, in view of the amendments to claim 1, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 1 be reconsidered and withdrawn.

With respect to claim 1, the Examiner is further of the opinion that

[C]laim 1 recites the limitation “the same restriction enzyme” in step a) of the claim. There is insufficient antecedent basis for this limitation in the claim because there is no phrase “restriction enzyme” before “the same restriction enzyme”.

Applicants respectfully submit that, in view of the amendments to claim 1, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 1 be reconsidered and withdrawn.

With respect to claim 1, the Examiner is further of the opinion that

[C]laim 1 recites the limitation “the cleaved DNA construct” in step c) of the claim. There is insufficient antecedent basis for this limitation in the claim because there is no phrase “cleaved DNA construct” in steps a) and b).

Applicants respectfully submit that, in view of the amendments to claim 1, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 1 be reconsidered and withdrawn.

With respect to claim 1, the Examiner is further of the opinion that claim 1 is “vague and indefinite”

[i]n view of step d) because it is unclear that said 5' restriction enzyme recognition sequence of said first desired DNA unit is from the ligated product containing a DNA modification generated in step c) or not.

Applicants respectfully submit that, in view of the amendments to claim 1, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 1 be reconsidered and withdrawn.

With respect to claim 1, the Examiner is further of the opinion that claim 1 is “vague and indefinite”

[b]ecause there are two different steps e) in the claim. In view of the whole claim, it appears that the first step e) should be deleted.

Applicants respectfully submit that, in view of the amendments to claim 1, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 1 be reconsidered and withdrawn.

With respect to claim 1, the Examiner is further of the opinion that claim 1 is “vague and indefinite”

[i]n view of step f) because it is unclear that said 5' restriction enzyme recognition sequence of said first desired DNA unit is from the next ligated product containing a DNA modification generated in step c) or not.

Applicants respectfully submit that, in view of the amendments to claim 1, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 1 be reconsidered and withdrawn.

With respect to claim 1, the Examiner is further of the opinion that claim 1 is “vague and indefinite”

[i]n view of steps e) to g. Since the cleaved next ligated product produced from step f) in step g) is different from the cleaved ligated product from step d), it is unclear how to perform step g) by repeating steps e) and f) using the cleaved ligated product from step d).

Applicants respectfully submit that, in view of the amendments to claim 1, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 1 be reconsidered and withdrawn.

With respect to claim 4, the Examiner is of the opinion that

[C]laim 4 recites the limitation “the cleaved DNA construct from step b)” in step c) of the claim. There is insufficient antecedent basis for this limitation in the claim because there is no phrase “cleaved DNA construct” in step b).

Applicants respectfully submit that, in view of the amendments to claim 4, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 4 be reconsidered and withdrawn.

With respect to claim 4, the Examiner is further of the opinion that claim 4 is “vague and indefinite”

[b]ecause it is unclear whether an accessible Xba I site in step d) is identical to an accessible Xba I site in step b) or not. If an accessible Xba I site in step d) is identical to an accessible Xba I site in step b), “an accessible Xba I site” in step d) should be “the accessible Xba I site”.

Applicants respectfully submit that, in view of the amendments to claim 4, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 4 be reconsidered and withdrawn.

With respect to claim 4, the Examiner is further of the opinion that claim 4 is “vague and indefinite”

[i]n view of steps e) to g). Since the cleaved next ligated product produced from step f) in step g) is different from the cleaved ligated product from step d), it is unclear how to perform step g) by repeating steps e) and f) using the cleaved ligated product from step d).

Applicants respectfully submit that, in view of the amendments to claim 4, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 4 under U.S.C. 112, second paragraph, be reconsidered and withdrawn.

With respect to claim 5, the Examiner is of the opinion that

[C]laim 5 recites the limitation “the restriction enzyme recognition sequences” in the claim. There is insufficient antecedent basis for this limitation in the claim because there is no phrase “the restriction enzyme recognition sequences” in claim 5.

Applicants respectfully submit that, in view of the amendments to claim 5, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 5 be reconsidered and withdrawn.

With respect to claim 8, the Examiner is of the opinion that claim 8 is “vague and indefinite”

[b]ecause it is unclear that the ligated product in the claim means the ligated product from steps c) and d) or the next ligated product from steps e) and f).

Applicants respectfully submit that, in view of the amendments to claim 8, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 8 be reconsidered and withdrawn.

With respect to claim 9, the Examiner is of the opinion that claim 9 is “vague and indefinite”

[i]n view of steps e) to g). Since the next cleaved product produced from step f) in step g) is different from the next cleaved product from step e), it is unclear how to perform step g) by repeating step f) using the cleaved ligated product from step d).

Applicants respectfully submit that, in view of the amendments to claim 9, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 9 be reconsidered and withdrawn.

With respect to claim 10, the Examiner is of the opinion that claim 10 is “vague and indefinite”

[i]n view of steps d) to f). Since the cleaved product produced from step e) in step f) is different from the cleaved product produced from step c) in step e), it is unclear how to perform step f) by repeating steps d) and e) using the cleaved product produced from step c) in step e).

Applicants respectfully submit that, in view of the amendments to claim 10, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 10 be reconsidered and withdrawn.

With respect to claim 13, the Examiner is of the opinion that claim 13 is “vague and indefinite”

[b]ecause there is no phrase “a subsequent desired DNA unit” in step c) of claim 9 or 10.

Applicants respectfully submit that, in view of the amendments to claim 10, the foregoing rejection has been rendered moot. Applicants respectfully request that this rejection of claim 13 be reconsidered and withdrawn.

SUMMARY

In view of the above amendments, Applicant believes that the present application is in condition for allowance.

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Respectfully submitted,

By



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